

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Marvin BIENN, <i>et al.</i>	§	Docket No.: 22171.438
	§	
Serial No.: 10/599,944	§	Examiner: Amirmokri, Jalaledin
	§	
Filed: April 15, 2005	§	Art Unit: 2617
	§	
For: System and Method for Providing Early	§	Conf. No.: 7009
Ringback by a Home Legacy Mobile	§	
Station Domain Network	§	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. INTRODUCTION

The present paper is being filed under the Official Gazette Notice of July 12, 2005, and in response to the final Office action mailed August 12, 2009, in connection with the above-noted application. A Notice of Appeal, as well as a Petition for Extension of Time Under 37 CFR § 1.136(a) requesting a one-month extension, each with the proper fee, are being filed concurrently with this paper. It is assumed that no additional fees are required, but if any additional fees are required, the Commissioner is hereby authorized to charge any fees, including those for any extensions of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

II. REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

In the final Office action mailed August 12, 2009, claims 1-3, 5, 8-10, 12, and 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0027569 to Ejzak (hereinafter "Ejzak") in view of U.S. Patent No. 6,738,615 to Chow et al. (hereinafter "Chow") and claims 4, 6, 7, 11, 13, 14, 19, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ejzak in view of Chow and further in view of U.S. Patent Application Publication No. 2002/0167946 to Gallant ("hereinafter "Gallant"). Applicants submit that the Examiner has made clear errors in rejecting the claims. In the present application, a prima facie case of obviousness does not exist for the claims for the reasons set forth below.

MPEP 2143.03 states that “‘All words in a claim must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).” However, in the present matter, the Examiner has not shown that all words in the claims have been considered.

In particular, independent claim 1 recites, *inter alia*:

receiving-, by the home mobile station domain from the servicing mobile station domain, a first message that requests the home mobile station domain to provide a call progress signal to the calling party prior to establishment of a bearer path between the serving mobile station domain and a telephone network of the calling party; and providing, by the home mobile station domain, a first call progress signal to the calling party.

The Examiner concedes on page 6 of the Office action that Ejzak fails to teach this element and proceeds to cite column 68, lines 50-64, of Chow as doing so. The cited portion of Chow is reproduced below in its entirety for ease of reference:

At this point, the MS 101 may tune to the traffic channel. When the VAP 103 detects that the MS 101 is on the traffic channel via a DVCC status change (step 3323), the MS 101 may cut through the ISDN/B-Channel and initiate the Alerting procedures to both the call legs (i.e., in both the LDS 104 and MS 101 directions). The VAP 103 may send an IS-136 Alert-With-Info message to the MS 101 (step 3325) and wait for an IS-136 Mobile ACK message from the MS 101 (step 3351). When the VAP 103 receives the Mobile ACK message, the VAP 103 may start a TT4 timer 3326 and send a Q.931 Alerting message to the LDS 104 (step 3327). Upon receipt of the Q.931 Alerting message, the LDS 104 may send an ISUP ACM message to the switch in the PSTN 125 (step 3329) and generate a ring-back tone towards the calling party (step 3331).

In particular, while the cited portion of Chow mentions generating a ring-back tone toward the calling party, it fails to teach receiving by the home mobile station domain from the servicing mobile station domain a request that the home mobile station domain generate such a signal prior to the establishment of a bearer path between the serving mobile station domain and the telephone network of the calling party, as clearly required by claim 1.

In view of the foregoing, it is apparent that the subject rejection of claim 1 is not supported by the cited combination and should be withdrawn. Independent claims 8 and 15 include limitations similar to those of claim 1 and are therefore also deemed to be in condition for allowance for the reasons set forth above. Claims 2-7, 9-14, and 16-20 depend from and further limit independent claims 1, 8, and 15, and are therefore also allowable for at least that reason.

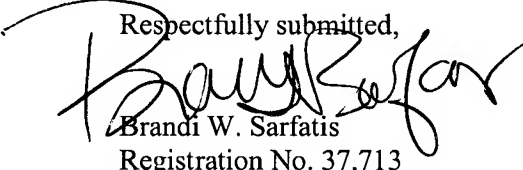
Thus, for the foregoing reasons, the Examiner’s burden of factually supporting a prima facie case of obviousness clearly cannot be met, and the rejection of claims 1, 8, and 15 under 35 U.S.C. §103 should be withdrawn. Claims 2-7, 9-14, and 16-20 depend from and further limit independent claims 1,

8, and 15, and are therefore also deemed to be in condition for allowance at least by virtue of such dependency.

III. CONCLUSION

In view of the fact that there are clear errors in the Examiner's position, as demonstrated above, it is apparent that the rejection of the pending claims under 35 U.S.C. §103 is not supported by the references and should therefore be withdrawn. Accordingly, all of the pending the claims in the application being in condition for allowance, such action is respectfully requested.

Respectfully submitted,


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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

22171.438

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on November 18, 2009

Signature Ellen Lovelace

Typed or printed name Ellen Lovelace

Application Number

10/599,944

Filed

April 15, 2005

First Named Inventor

Marvin BIENN, et al.

Art Unit

2617

Examiner

Amirmokri, Jalaledin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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